

REMARKS

Claims 1, 3-47, 49-80, 82-103 and 112-114 are pending and under consideration. Claims 1, 41, 47, 50 and 114 are amended. Claims 112 and 113 are allowed. Claims 13, 23-35, 56 and 89 are objected to.

Rejections Under 35 U.S.C. § 103

The Examiner's rejection of Claims 1, 3-12, 15-21, 41, 44-47, 49-56, 58-72, 78-80, 82-88, 91-98, 100-101 and 103 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,336,860 to Webb ("Webb") in view of U.S. Patent No. 6,609,978 to Paulsen, ("Paulsen") is respectfully traversed for at least the reasons given below.

The present invention discloses a gaming machine with two games of chance: a first game of chance and a second game of chance. The player can win the second game of chance without obtaining a win in the primary, or first game of chance. Any prize achieved in the second game is awarded, again irrespective of what happens in the first game. The second game of chance has the potential, on every play, for achieving a prize award. Thus, it is possible for the player to win both the first game of chance and the second game of chance on the first play, or just the second game. But whatever happens in the second game is independent of the first game outcome. Additionally, the present invention teaches that the secondary game of chance is a game in which a non-monetary prize can be achieved.

Webb is a video display game with a matrix of game symbols. The matrix consists of nine areas totaling 8 lines (column 1, line 66 – column 2, line 2). The matrix is populated with symbols that have at least two defining criteria (column 2, lines 54-55). The player selects the number of lines (up to 8) of the matrix to play.

The matrix of Webb does not equate to a first game of chance and a second game of chance. Each line of the matrix defines a "mode of play" (i.e., a single line, multi-line, etc.) of a single game of chance, as the specification recites at column 8, lines 33-35. See also column 4, lines 8-10 and 27-30. Each line of the matrix in Webb is not a separate game of chance. The specification clearly discloses the invention as "a game of chance centered around a matrix of symbols." (column 8, lines 29-33). Webb is quite simply a single game of chance with the lines selected from the matrix defining a mode of play. Most distinctive, Webb fails to teach or suggest a "first game of chance" and a "second game of chance" altogether. Furthermore, Webb

does not disclose operating a second game of chance “irrespective of any result occurring in a first game of chance” claimed by the present invention because there is quite simply only one game of chance in Webb. Moreover, as the Examiner notes, “Webb lacks the explicit teaching of the prize being non-monetary.” (Office Action, p. 3).

In the alternative, Paulsen does not satisfy the deficiencies of Webb because there is no teaching, suggestion, or motivation to combine these references. Webb actually teaches away from Paulsen. Webb discloses that a player is awarded credits according to the payout schedule for the game. (column 4, lines 33-35). In addition, Webb discloses payouts that vary with the at least two defining criteria of the symbols of a winning combination. (column 2, lines 65-67; column 8, lines 5-12 and 38-40). “Credits” and “varying payouts” implicate a monetary award. Thus, this teaches away from the non-monetary award of Paulsen. There quite simply is no teaching, suggestion, or motivation to combine Paulsen with Webb.

Independent Claims 1, 41, 47, 78 and 96 clearly recite a “first game of chance”, a “second game of chance”, operating a second game of chance “irrespective of any result occurring in a first game of chance” and a “non-monetary prize award”, all of which Webb fails to teach or suggest. Moreover, Paulsen fails to fulfill the deficiencies of Webb as there is no motivation to combine these references to teach or suggest independent claims 1, 41, 47, 78 and 96. Since Applicants’ independent claims are in condition for allowance, all dependent claims thereon are also in condition for allowance.

The Examiner’s rejection of Claim 102 under 35 U.S.C. §103 as being unpatentable over Webb in view of Paulsen, in further view of U.S. Patent No. 6,468,156 to Hughes-Baird et al., (“Hughes-Baird”) is moot in light of the arguments above. Dependent Claim 102 plainly contains all of the limitations of independent Claim 96. As distinguished above, independent Claim 96 is not obvious in view of any combination of the cited references. Since Claim 96 is in condition for allowance, all dependent claims thereon are also in condition for allowance.

The Examiner’s rejection of Claims 14, 36-39, 57, 73-77, 90, 99 and 114 under 35 U.S.C. §103 as being unpatentable over Webb in view of Paulsen, in further view of U.S. Patent No. 6,311,976 to Yoseloff et al., (“Yoseloff”) is respectfully traversed for at least the reasons given below.

Yoseloff does not fulfill the deficiencies of Webb and Paulsen, described and distinguished above.

Yoseloff does not teach operating a second game of chance “irrespective of any result occurring in a first game of chance”. Yoseloff discloses a wagering game with a first game segment and a second game segment that are operated separately. The second game segment of Yoseloff is “a bonus event or jackpot event” (column 7, lines 53-55). The second game segment is initiated upon a predetermined triggering event such as the appearance of three similar symbols on the reel (column 11, lines 66 – column 12, line 2). The second game segment may not be played at all if the triggering event does not occur in the first segment (column 12, lines 3-5). Thus, in contrast to Applicants foregoing Claims, Yoseloff does not teach playing the second game segment irrespective of any result occurring in the first game segment since, in Yoseloff, three similar symbols in the first game segment initiates the bonus event. Moreover, and most distinctive, Yoseloff fails to teach a “first game of chance” and a “second game of chance” that are operated “in conjunction.”

Independent Claims 36 and 114 and dependent Claims 14, 37-39, 57, 73-77, 90, and 99 all include the limitation that the second game of chance is operated in conjunction with a first game of chance and irrespective of any result occurring in the first game distinguishing Applicants’ invention over the cited references. As distinguished above, *supra*, independent Claims 1, 36, 47, 78 and 96 are not obvious in view of any combination of the cited references. Since Applicants’ independent claims are in condition for allowance, all dependent claims thereon are also in condition for allowance.

The Examiner’s rejection of Claims 22, 40 and 42-43 under 35 U.S.C. §103 as being unpatentable over Webb in view of Paulsen, in further view of U.S. Patent No. 6,685,563 to Meekins et al., (“Meekins”) is respectfully traversed for at least the reasons given below.

Meekins does not fulfill the deficiencies of Webb and Paulsen, described and distinguished above.

Meekins does not teach operating a second game of chance “irrespective of any result occurring in a first game of chance”. Meekins is a method of operating a wagering game with a base unit and bonus unit (column 2, lines 45-55). The base unit is played wherein a winning payout increases the player’s credits on a credit meter or payout through a coin exit chute (column 4, lines 42-45). The bonus game initiates when the coin or credit threshold exceeds a predetermined value (column 4, lines 42-45). The bonus game is dependent on the result occurring in the base game (column 4, lines 63-64; column 6, lines 30-34). A winning condition

in the base game increases the player's coins or credits which in turn advances the player to the predetermined threshold value required for playing the bonus game (column 6, lines 30-34). Moreover, Meekins fails to teach a "first game of chance" and a "second game of chance" that are operated "in conjunction."

In contrast to Applicants foregoing Claims, Meekins does not teach each and every limitation of independent Claims 1, 40 and 41. As distinguished above, independent Claims 1, 40 and 41 are not obvious in view of any combination of the cited references. In addition, dependent Claims 22 and 42-43 contain further limitations that the cited prior art raised in rejection does not teach or suggest as a whole. Since independent Claims 1, 40 and 41 are in condition for allowance, all dependent claims thereon are also in condition for allowance.

Allowable Subject Matter

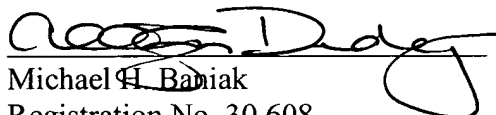
Applicants acknowledge the allowability of Claims 112-113. In addition, Applicants acknowledge the objection to Claims 13, 23-35, 56 and 89 as being dependent upon a rejected base claim, but allowable if rewritten in independent form. Applicants suggest however, in view of this Response, that these Claims should be allowable without the need for a re-write. The Applicants respectfully request reconsideration of the Examiner's objections.

Allowance of this application is respectfully requested.

Respectfully submitted,

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